

### **REMARKS**

In the Final Office Action mailed on April 18, 2007, the Office (1) rejected claims 9-10 and 12-16 under 35 U.S.C. §101 as directed to non-statutory subject matter; (2) rejected claims 10 and 12-16 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; (3) rejected claims 1, 3-10, 12-16, 22, and 24-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement; (4) rejected claims 10 and 12-16 under 35 U.S.C. §112, second paragraph, as being indefinite; (5) rejected claims 1, 3-5, 7-10, 12-13, 15-16, 22, and 24-25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. U.S. 2004/0133855A1 to Blair (hereinafter, "Blair"); and (6) rejected claims 6 and 14 under 35 U.S.C. §103(a) as being unpatentable over Blair and further in view Applicants' Admitted Prior Art. Applicants respectfully request reconsideration and allowance of the subject application. Claims 1, 3-10, 12-16, 22, and 24-25 are pending in this application.

### **Replacement Drawings**

Replacement formal drawings are filed concurrently herewith, in which Applicant has corrected an informality in Figure 1. Specifically, the label for component 102 and the reference numeral referring to component 108b were amended to match the description in the specification. No new matter has been added.

### **Rejections under 35 U.S.C. §101**

The Office rejected claims 9, 10 and 12-16 under 35 U.S.C. §101 as directed to non-statutory subject matter. Applicants respectfully submit that claims 9, 10, and 12-16 are allowable for the reasons stated below.

#### **Claim 9**

Claim 9 has been amended to comply with the requirements of 35 U.S.C. §101. Applicants respectfully submit that claim 9 complies with 35 U.S.C. §101.

#### **Claims 10 and 12-16**

Claim 10 has been amended to comply with the requirements of 35 U.S.C. §101.

“the serialized binary bit streams facilitates ~~can be visually rendered~~ visual rendering and an end user ~~may interact~~ interaction with the serialized binary bit streams through a user interface . . .”

As amended, claim 10 fully complies with the statutory requirements under 35 U.S.C. §101. Specifically, “visual rendering” and “end user interaction” are more than “the physical characteristics of a form of energy, . . . define energy or magnetism . . .” (Official Gazette notice of 22 Nov. 2005, Annex IV).

Claims 12-16 depend from claim 10, and thus claims 12-16 are allowable for the same reasons as claim 10. Therefore, Applicants respectfully submit that claims 10 and 12-16 comply with 35 U.S.C. §101.

### **Rejections under 35 U.S.C. §112, first paragraph, written description**

The Office rejected claims 10 and 12-16 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Applicants respectfully submit that claims 9, 10, and 12-16 are allowable for the reasons stated below.

**Claim 10**

Claim 10 has been recited below in final form for convenience of the reader.

A computer-readable medium comprising instructions that when executed:

*capture a presentation result of processed video content in an original markup language*, wherein the presentation includes layout, rendering, UI interaction, and dynamic aspects of the video content from the original markup language; and

create one or more serialized binary bit streams corresponding to the presentation result, wherein the serialized binary bit streams facilitates visual rendering and end user interaction with the serialized binary bit streams through a user interface, and wherein the capture further comprises processing the video content in the original markup language with a markup-specific routine that is specific to the original markup language, and a client-specific routine specific to a predetermined client for rendering the one or more serialized binary bit streams so as to be consistent with the original markup language.

In the Final Office Action, the Office stated “Claim 10 describes emulation results of an application, and creation of streams using these results. There is no disclosure of these capturing presentation results nor does the specification even appear to use these terms at all.” (Final Office Action, Paragraph 7, Lines 5-8). Applicants had amended claim 10 in the Response to Office Action mailed February 2, 2007 (hereinafter, “Last Response”) to remove “emulation.” As shown above, claim 10 recites: “capture a presentation result of processed video content in an original markup language.” The terms used are known by one skilled in the relevant art.

Now turning to the “creation of streams” language, Applicants point to the specification for support. The specification describes, “The client-specific routine 108b, which is specific to a particular low-resource client represented by a block 112a in Figure 1, encodes the output of the renderer at block 106b to output a serialized binary stream.” (Specification, Paragraph 0024, Lines 8-11). Additionally, “creation of streams” is also represented in Figure 1, elements 108b, 110, and 112b. In addition, one skilled in the relevant would understand “creation of streams” in reference to transmission of binary data (Figure 1, 110) from program content (Figure 1, 102). Therefore, Applicants submit that claims 10 and 12-16 comply with the written description requirement of 35 U.S.C. §112, first paragraph.

#### **Rejections under 35 U.S.C. §112, first paragraph, enablement**

The Office rejected claims 1, 3-10, 12-16, 22, and 24-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully submit that claims 9, 10, and 12-16 are allowable for the reasons stated below.

#### **Claim 1**

The Final Office Action states, “the claims generally recite translating video content into a serialized binary format. No details are of this conversion are given in the specification . . . [or] as to what the binary format actually entails. Therefore one of ordinary skill in the art would have to resort to undue experimentation . . . .” (Final Office Action, Paragraph 8, Lines 5-8).

The MPEP §2164.05(b) requires the specification to be enabling to persons skilled in the art. Further, “The relative skill of those in the art refers to the skill of those in the art in relation to the subject matter to which the claimed invention pertains at the time the application was filed.” (MPEP §2164.05(b)).

The Office has rejected Applicants claims 1, 3-10, 12-16, 22, and 24-25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. U.S. 2004/0133855A1 to Blair. Blair discloses, “Fig. 3 depicts a server function; namely, a resolver and translator 310 that processes a mark-up file such as XML, XHTML and the like, as well as any CSS style sheet or in-line styles 312 to produce a binary file 320.” (Blair, Paragraph 0028, Lines 3-6). Additionally, Blair discloses, “The file and resolved style information are then compressed 316 into a binary data file 320 which is provided to a client presentation engine 330.” (Blair, Paragraph 0028, Lines 9-12).

As stated in Chisum, “Federal Circuit decisions emphasize that ‘[a] patent need not disclose what is well known in the art.’” In *Atmel Corp. v. Information Storage Devices, Inc.* (1999), the court discussed the point.

Paragraph 1 [35 U.S.C. §112] permits resort to material outside of the specification in order to satisfy the enablement portion of the statute because it makes no sense to encumber the specification of a patent with all the knowledge of the past concerning how to make and use the claimed invention. One skilled in the art knows how to make and use a bolt, a wheel, a gear, a transistor, or a known chemical starting material. The specification

would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel.

(Chisum on Patents: § 7.03).

Therefore, under the MPEP §2164.05(b) and Federal Court decisions, as discussed by Chisum §7.03, Applicants submit that one of ordinary skill in the art at the time of the invention would be enabled to translate video content into a serialized binary format having the disclosure of Blair.

**Claims 3-10, 12-16, 22, and 24-25**

Regarding independent claims 10 and 22, Applicants rely on the same reasoning as presented above for claim 1, and thus submit that claims 10 and 22 are allowable. Claims 3-9 depend from claim 1, claims 12-16 depend from claim 10, and claims 24-25 depend from claim 22. Therefore, claims 3-9, 12-16, and 24-25 are allowable for the same reasons as claim 1, 10, and 22, respectively. Therefore, Applicants respectfully submit that claims 1-10, 12-16, 22, and 24-25 comply with the enablement requirement of 35 U.S.C. §112, first paragraph.

**Rejections under 35 U.S.C. §102(e)**

The Office rejected claims 1, 3-5, 7-10, 12-13, 15-16, 22, and 24-25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. U.S. 2004/0133855A1 to Blair. Applicants respectfully submit that claims 1, 3-5, 7-10, 12-13, 15-16, 22, and 24-25 are allowable for the reasons stated below.

The Blair reference pertains generally to providing a presentation engine adapted for use by a constrained resource client device. More specifically, Blair pertains to the conversion of information streams by a near side server into feature

or function reduced information streams and/or data files which are subsequently propagated to a client. (Blair, paragraph 0016).

### **Claim 1**

As such, Blair does not disclose every element of Applicants' claim 1. Claim 1 has been recited below in final form for convenience of the reader.

A method comprising compiling formatted video content into a serialized binary format that includes one or more of layout, rendering, user interface (UI) interaction, and dynamic aspects of the formatted video content, wherein the formatted video content includes an original markup language, and the compiling further comprises processing the formatted video content in the original markup language with *a process that is specific to the original markup language and a process that is specific to a predetermined client for rendering the video content in the serialized binary format so as to be consistent with the original markup language.*

In the Final Office Action, the Office states, "Blair teaches the format is specific to XML (para. 16). Blair teaches a specific embodiment where only one type of client is used (para. 20). Therefore, the process of that embodiment is specific to that client as it is the only one it contemplates using." (Final Office Action, Paragraph 12, Lines 6-9).

In Paragraph 16, Blair discloses, "In one embodiment, XML information streams and/or data files intended for use by one or more client devices are converted or transcoded by a near side server into feature or function reduced information streams and/or data files which are subsequently propagated to the client." (Blair, Paragraph 16, Lines 1-6). In paragraph 20, Blair discloses, "In one embodiment of the invention, the client comprises an STB such as the model DCT2000 manufactured by Motorola Corporation of Schaumburg, Ill. For purposes of this description, it will be assumed that the client or STB 104

comprises a device having a relatively limited amount of memory and/or processing power compared to a full featured (e.g., desktop) computer.” (Blair, Paragraph 0020, Lines 8-15).

Applicants assert that the language and device disclosed in paragraphs 16 and 20 are merely examples of possible languages and devices, and Blair does not disclose “a process that is specific to the original markup language” or “a process that is specific to a predetermined client,” as recited in claim 1. For example, paragraph 16 of Blair uses XML as “one embodiment,” but fails to specify any detail about making XML “a process that is specific to the original markup language.” According to Blair, the same or different process may be used in other embodiments, using other information streams.

Similarly, Blair’s example in paragraph 20 includes a STB as an example, but again fails to disclose providing the STB, “a process that is specific to a predetermined client.” Further, Blair discusses devices other than the unique STB presented in paragraph 20 as, “the client or STB 104 comprises a device having a relatively limited amount of memory and/or processing power compared to a full featured (e.g., desktop) computer.” However, despite this broadening language, Blair fails to clarify “a process that is specific to a predetermined client.” According to Blair, the same process may be used for any device or STB 104, as described in paragraph 20.

Even assuming *arguendo* that Blair were to teach a specific process as XML in paragraph 16 and a specific device in paragraph 20, which Applicants assert Blair fails to disclose, Blair still fails to disclose the entire elements of claim 1. Applicants point to a disconnection between paragraphs 16 and 20 of Blair.



Blair fails to disclose “a process that is specific to the original markup language *and* a process that is specific to a predetermined client,” in the same embodiment. In fact, Blair fails to disclose a single embodiment including a specific “language” associated with a specific “predetermined client,” as recited in claim 1. For example, Blair fails to tie XML to the STB model as described in paragraph 20. More specifically, Blair discloses XML “in one embodiment” in paragraph 16 while disclosing the Motorola STB in paragraph 20 as an example of a STB “in one embodiment.” Therefore, Blair fails to disclose “a process that is specific to the original markup language *and* a process that is specific to a predetermined client.”

**Claims 3-10, 12-16, 22, and 24-25**

Regarding independent claims 10 and 22, Applicants rely on the same reasoning as presented above for claim 1, and thus submit that claims 10 and 22 are allowable. Claims 3-9 depend from claim 1, claims 12-16 depend from claim 10, and claims 24-25 depend from claim 22. Therefore, claims 3-9, 12-16, and 24-25 are allowable for the same reasons as claim 1, 10, and 22, respectively. Therefore, Applicants respectfully submit that claims 1-10, 12-16, 22, and 24-25 are in condition for allowance.

**Rejections under 35 U.S.C. §103(a):**

The Office rejected claims 6 and 14 under 35 U.S.C. §103(a) as being unpatentable over Blair and further in view Applicants’ Admitted Prior Art. Applicants respectfully submit that claims 6 and 14 are allowable for the reasons stated below.

In the Final Office Action, the Office has improperly concluded that Applicants have admitted prior art. The Office states, “Applicants admit (as per MPEP §2144.03 C, no traversal of Official Notice of 10/06/2006 is taken as an admission) . . . .” (Final Office Action, Paragraph 15, Lines 3-4). The MPEP §2144.03 C states, “To adequately traverse such a finding, an applicant must specifically point out the supposed error in the examiner’s action. . . .” The MPEP also states, “If the applicant’s traverse is not adequate, the examiner should include an explanation as to why it was inadequate.”

Applicants clearly traversed the official notice in the Last Response (dated 02/02/2007), on page 28, line 23 stating, “The Applicant[s] respectfully transverses this rejection.” However, to meet the burden under MPEP §2144.03 C, the Applicants must also “specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.” (MPEP §2144.03 C). In a bona fide response to the Last Action, Applicants relied on the dependency of claim 6 to an allowable base claim 1, and similarly the dependency of claim 14 to an allowable base claim 10, therefore asserting that the Office has not met its burden under MPEP §2144.03 C, as required by Applicants under this section.


Applicants respectfully request the Office to withdraw the Official Notice, or as stated in the MPEP §2144.03 C, demand that the Office produce authority for this statement regarding the Official Notice. Applicants submit that dependent claims 6 and 14 are not rendered obvious by Blair based on their dependency on claims 1 and 10, respectively, and are in condition for allowance.

**Conclusion**

Claims 1, 3-10, 12-16, 22, and 24-25 are in condition for allowance. Applicants respectfully request reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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Enclosures: Replacement Formal Drawings